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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/973,293	12/01/97	SCHWARTZ	R 8001.101/00

ALEX L YIP  
LONDA & TRAUB LLP  
20 EXCHANGE PLACE  
37TH FL  
NEW YORK NY 10005

LM01/0218

EXAMINER

COSIMANO, E

ART UNIT	PAPER NUMBER
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2761

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DATE MAILED: 02/18/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/973,293

Applicant(s)

SCHWARTZ ET AL.

Examiner

Edward R. Cosimano

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- 1) ☒ Responsive to communication(s) filed on 01 December 1997.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-198 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☒ Claim(s) 35-81 & 139-183 is/are allowed.
- 6) ☒ Claim(s) 1-35, 82-138 & 184-192 is/are rejected.
- 7) ☒ Claim(s) 193-198 is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 1997 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☒ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☐ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

## Attachment(s)

- 14) ☒ Notice of References Cited (PTO-892)
- 15) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 16) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.
- 17) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 18) ☐ Notice of Informal Patent Application (PTO-152)
- 19) ☐ Other: \_\_\_\_\_.

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1. Applicant should note the changes to patent practice and procedure effective December 01, 1997 as published in the Federal Register, Vol 62, No. 197, Friday October 10, 1997.

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by its Serial Number and filing date is required. See M.P.E.P. §§ 602.01 and 602.02.

2.1 The oath or declaration is defective because:

A) Non-initialed and/or non-dated alterations have been made to the oath or declaration, note inventor Eskandari. See 37 CFR § 1.52(c).

B) Proof of authority of the legal representative under 37 CFR § 1.42 has been omitted and must be provided. Note deceased inventor Gardner.

3. Applicant is reminded of the proper content of an Abstract of the Disclosure.

A) A patent abstract is a concise statement of the technical disclosure of the patent and should include that which is new in the art to which the invention pertains. If the patent is of a basic nature, the entire technical disclosure may be new in the art, and the abstract should be directed to the entire disclosure. If the patent is in the nature of an improvement in an old apparatus, process, product, or composition, the abstract should include the technical disclosure of the improvement. In certain patents, particularly those for compounds and compositions, wherein the process for making and/or the use thereof are not obvious, the abstract should set forth a process for making and/or use thereof. If the new technical disclosure involves modifications or alternatives, the abstract should mention by way of example the preferred modification or alternative.

B) The abstract should not refer to purported merits or speculative applications of the invention and should not compare the invention with the prior art.

C) Where applicable, the abstract should include the following:

- (1) if a machine or apparatus, its organization and operation;
- (2) if an article, its method of making;

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- (3) if a chemical compound, its identity and use;
- (4) if a mixture, its ingredients;
- (5) if a process, the steps.

D) Extensive mechanical and design details of apparatus should not be given.

E) The abstract should be in narrative form and generally limited to a single paragraph ON A SEPARATE SHEET within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said", should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details. The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," *etc.*

3.1 This application does not contain an Abstract of the Disclosure as required by 37 C.F.R. § 1.72(b). An Abstract on a separate sheet is required.

4. The drawings are objected to because:

A) the drawings must show every feature of the invention specified in the claims, therefore, the subject matter of claims 88, 89, 91, 92, 94, 95, 97-102, 125 & 192 must be shown in the drawings as required by 37 CFR § 1.83(a) or the feature(s) canceled from the claim(s) (note: no new matter should be entered).

Correction is required.

4.1 Applicant is required to submit a proposed drawing correction in response to this Office action (37 CFR § 1.121(a)(3)(ii)). However, correction of the noted defect can be deferred until the examiner allows the application.

5. The disclosure is objected to because of the following informalities:

A) the following errors have been noted in the specification:

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(1) as can be seen in fig. 1, at page 6, line 18, "115" should be --155--.

(2) the specification lacks a statement of --We claim:--, (see MPEP 608.01(m)).

B) the subject matter of claims 88, 89, 91, 92, 94, 95, 97-102, 125 & 192 lacks antecedent basis within the specification as required by 37 CFR § 1.75(d1).

Appropriate correction is required.

6. The specification and drawings have not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification or drawings. Applicant should note the requirements of 37 CFR § 1.74, § 1.75, § 1.84(o,p(5)) & § 1.121(a)(1)-1.121(a)(6).

7. Claims 88, 89, 91, 92, 94, 95, 97-102, 125 & 192 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7.1 The subject matter of claims 88, 89, 91, 92, 94, 95, 97-102, 125 & 192 lacks antecedent basis within the specification as required by 37 CFR § 1.75(d1).

7.2 For the above reason, applicant has failed to particularly point out what is regarded as the invention.

8. Claim 95 rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim.

8.1 Since claim 95 is identical to claim 94 and both claims 94 and 95 depend from claim 93, claim 95 fails to limit claim 94.

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

9.1 Claims 8-35 & 107-138 rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Fougere et al (4,743,747) or Pastor (4,853,961 or 4,893,338) or Sansone et al (4,831,555 or 4,837,701 or 4,947,333) or Hart et al (4,853,864) or Gilham (4,934,846).

9.2 Claims 8-35 & 107-138 rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Manduely et al (5,650,934).

9.3 In regard to claims 8-35 & 107-138, any one of either Fougere et al ('747) or Pastor ('961 or '338) or Sansone et al ('555 or '701 or '333) or Hart et al ('864) or Gilham ('846) or Manduely et al ('934) disclose a postage metering system in which attributes of an item of mail are used to determine the appropriate postage. Then if the required postage is approved a postage indicia and proof of payment are generated and printed on the item of mail so as to be visible to the mail processing equipment of the Post Office.

9.4 Claims 1-7, 82-106 & 184-191 rejected under 35 U.S.C. § 102(b) as being clearly anticipated by either Wright et al (4,802,218 or 4,900,903 or 4,900,904) or Talmadge (4,809,185 or 4,858,138) or Freytag (5,490,077).

9.5 Claims 1-7, 82-106 & 184-191 rejected under 35 U.S.C. § 102(e) as being clearly anticipated by either Freytag (5,602,743) or Lee et al (5,625,694) or Arsenault et al (5,651,103).

9.6 In regard to claims 1-7, 82-106 & 184-191 any one of Wright et al ('218 or '903 or '904) or Talmadge ('185 or '138) or Freytag ('077) or Freytag ('743) or Lee et al ('694) or

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Arsenault et al ('103) disclose a postage metering system in which attributes of an item of mail are used to determine the appropriate postage. Then postage security device (PSD), e.g. a separate module, is used to approve the required postage and if approved then a postage indicia and proof of payment are generated and printed on the item of mail so as to be visible to the mail processing equipment of the Post Office.

10. The examiner has cited art of interest, which does not teach or suggest:

A) the use of a postage indicia to cause to the postal carrier to provide a payment to another party (claims 35-81 & 139-183), and

B) the use of a postage indicia to cause to the postal carrier to provide a message to another party (claims 192-198),

11. Claim 192 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112. As allowable subject matter has been indicated, applicant's response must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 C.F.R. § 1.111(b) and section 707.07(a) of the M.P.E.P.

12. The shorten statutory period of response is set to expire 3 (three) months from the mailing date of this Office action.


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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward Cosimano whose telephone number is (703) 305-9783. The examiner can normally be reached Monday through Thursday from 7:30am to 6:00pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Voeltz, can be reached on (703)-305-9714. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3800.

13.1 The fax phone number for UNOFFICIAL FAXES for this group is (703) 305-0040.

13.2 The fax phone number for OFFICIAL FAXES for this group is either (703) 308-9051 or (703) 308-9052.

02/13/00

  
Edward R. Cosimano  
Primary Examiner A.U. 2761